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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/651,496	08/29/2003	Akihiko Tsuruoka	2003946-0058	9108
24280	7590	12/13/2005	EXAMINER	
CHOATE, HALL & STEWART LLP TWO INTERNATIONAL PLACE BOSTON, MA 02110			COPPINS, JANET L	
			ART UNIT	PAPER NUMBER

1626

DATE MAILED: 12/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/651,496

Applicant(s)

EISAI CO., LTD.

Examiner

Janet L. Coppins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 and 47-53 is/are pending in the application.
- 4a) Of the above claim(s) 45 and 47-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-15 and 31-44 is/are rejected.
- 7) ☒ Claim(s) 2-44 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-45 and 47-53 pending in the instant application.

Information Disclosure Statement

1. Applicant's Information Disclosure Statement, filed December 6, 2004, have been considered by the Examiner. Please refer to the signed copy of Applicant's PTO-1449 form submitted herewith.

Election/Restriction

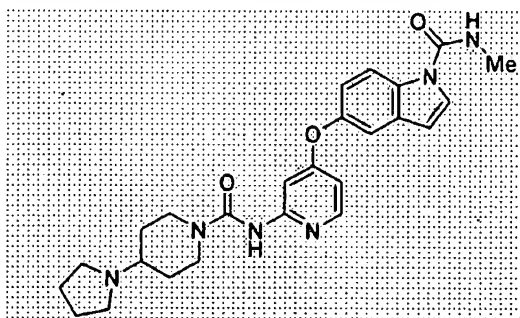
2. Receipt is acknowledged of Applicants' Response to the Restriction Requirement, submitted October 14, 2005, which has been reviewed by the Examiner and entered of record in the file. Applicants' election of Group I, **without** traverse, of claims 1-44, drawn to compounds of formula (I) and (II), is acknowledged.

3. Therefore, claims 45 and 47-53 withdrawn from further consideration, pursuant to 37 CFR 1.142(b), as being drawn to a non-elected invention.

Status of the Claims

4. Claims 1-45 and 47-53 pending in the application. Claims 45 and 47-53, drawn to methods of use, are currently withdrawn from consideration by the Examiner, as stated above.

Applicants have further elected the species of Example 46, the compound of the formula:



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The scope of the invention of the elected subject matter is as follows,

Compounds according to formula (I) or (II), wherein: R_1 is as defined, R_2 - R_8 are hydrogen, R_9 is as defined (excluding any heteroaryl or heterocyclic rings), limited to 6-membered nitrogen-containing rings, X_1 and X_2 are both carbon, and Y is as defined.

As a result of the election and the corresponding scope of the invention as identified above, the remaining subject matter of claims 1-44 **withdrawn** from further consideration pursuant to 37 CFR 1.142 (b) as being drawn to non-elected inventions (i.e. compounds and compositions within claims 1-44 that are excluded from the scope of the invention defined above), please refer to pages 3-4 of the Restriction Requirement which explain the practice set forth for defining the scope of an independent invention. The **withdrawn** compounds contain varying functional groups for the R_1 - R_9 and X_1 - X_2 moieties, including such rings as aziridine, azetidine, pyrrolidine, pyrimidine, pyrazine, etc. which are chemically recognized to differ in structure and function from the elected invention set, as defined above. This recognized chemical diversity of the functional groups can be seen by the various classification of these functional groups in the U.S. classification system, i.e. class 544 (pyrimidine and pyrazine), class 546 (pyradine or piperidine), class 548 (pyrrolidine), etc. Therefore the subject matter that has been withdrawn from consideration as being non-elected subject matter, differs materially in structure and composition and has been restricted properly, and a reference that anticipates the elected subject matter would not render obvious the withdrawn subject matter, and the fields of search would not be coextensive.

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Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-9, 11-15, 31-44 in part rejected under 35 U.S.C. 102(b) as being anticipated by Funahashi et al, WO 2002032872 A1. The WO document teaches substituted indolyl-pyridinyl derivatives that inhibit angiogenesis. Funahashi et al teach many species that are the same as those instantly claimed, please refer to RN 417714-80-8, RN 417715-10-7, RN 417715-09-4, RN 417715-08-3, 417724-86-8, 417724-87-9 and RN 417714-83-1(which read on compounds of formula (I) wherein X_1 and X_2 are carbon, Y is oxygen, R_2 - R_8 are hydrogen, and R_9 is $NR_{16a}R_{16b}$ wherein 16A is hydrogen and 16B is a cyclopropyl group); RN 417714-81-9 and RN 417714-82-0, RN 417714-97-7, 417721-97-2, (which read on compounds of formula (I) wherein X_1 and X_2 are carbon, Y is oxygen, R_2 - R_8 are hydrogen, and R_9 is $NR_{16a}R_{16b}$ wherein 16A is hydrogen and 16B is an aryl group).

The Examiner would like to point out that even though claims 35-44 are drafted in terms of future intended use, intended use has no bearing on the patentability of a compound or composition.

7. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

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Claim Objections

8. Claims 1-44 objected to as containing non-elected subject matter.
9. Claims 2-44 objected to as being dependent on rejected base claims.

Conclusion

10. Claims 1-45 and 47-53 are pending in the application, claims 45 and 47-53 are currently withdrawn from consideration, claims 1-9, 11-15, 31-44 are rejected, and claims 2-44 are objected to.

Telephone Inquiry

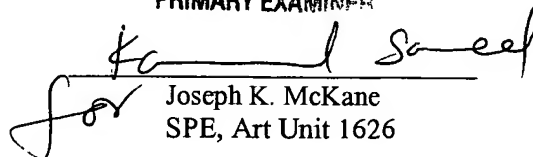
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L. Coppins whose telephone number is 571.272.0680. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571.272.0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Janet L. Coppins
December 10, 2005

KAMAL A. SAEED, PH.D.
PRIMARY EXAMINER


Joseph K. McKane
SPE, Art Unit 1626